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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,603	12/04/2003	Satoshi Nakama	03560.003408	6916

5514 7590 03/01/2007  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
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GONZALEZ, ANGEL F

ART UNIT	PAPER NUMBER
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2609

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/01/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/726,603

**Applicant(s)**

NAKAMA, SATOSHI

**Examiner**

Angel F. Gonzalez

**Art Unit**

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/04/2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/04/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 03/09/2004, 01/19/2006.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

2. The references listed on the Information Disclosure Statement filed on 03/09/2004 and 01/19/2006 have been considered by examiner (see attached PTO-1449).

### ***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Objections***

4. Claims 2 and 4 objected to because of the following informalities: The use of parentheses in claims 2 and 4 are improper since parentheses are used only for the reference character (see MPEP 608.01(m)). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3-4 are rejected under 35 U.S.C. 102(b) as being unpatentable in view of Koide (U.S. Patent Number 6,864,918).

As to claim 1, Koide (Fig. 1) discloses an imaging apparatus (100) for recording taken images on an internal recording medium (RAM 121) said imaging apparatus (see col. 3, line 65 through col. 4, line 3) comprising:

a first detecting unit (16) which detects the remaining available recording space of said internal recording medium (see col. 5 lines 30-35 and col. 11, lines 31-40);

a second detecting unit (17) which detects external recording devices (200 and 201) communicably connected through a network in the event that the remaining available recording space of said internal recording medium reaches a predetermined value (i.e. RAM 121 is full) (see col. 5, lines 35-42 and col. 8, lines 3-6);

and a control unit (200) which automatically performs switching of the recording medium for recording said taken images from said internal recording medium to a recording medium included in said external recording device detected by said second detecting unit (see col. 7, lines 19-29).

As to claim 3 and 4, Koide teaches an imaging apparatus comprising a digital video camera (see col. 3, lines 18-20).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C 103 (a) as being unpatentable over Koide in view of Roe (U.S. Patent No. 2004/0267914) or UPnP™ Device Architecture, Version 1.0 08 Jun 2000 (hereinafter simply referred to as UPnP™).

As to claim 2, note the discussion of Koide above. Koide does not teach detecting unit for detecting the external recording devices using UPnP. Roe teaches detecting unit for detecting external recording device using UPnP (see [0010], [0012] and [0015].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the UPnP as taught by Roe to the detecting unit of Koide because UPnP of Roe would provide benefit of avoiding the unnecessary code found in the control point or detecting unit, thereby it is more compact (i.e. less memory) and more efficient (i.e. faster responding) (see [0019] of Roe). UPnP™ teaches using UPnP the same way as Roe does. Thus, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to have provide UPnP as taught by UPnP™ to the detecting unit of Koide for the same reasons as discussed above.

### ***Conclusion***

9. The prior art made of record and relied upon is considered pertinent to applicant's disclosure.

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Kagasawa et al. (U.S. Patent 5,877,906) is cited to teach a device for switching between multiple recording devices.

Amram et al. (U.S. Patent 6,930,601) is cited to teach digital data exchange system.

Shiota et al. (U.S. Patent 6,337,712) is cited to teach system for storing picture image data recorded by digital camera.

McKain et al. (U.S. Patent 6,977,673) is cited to teach moving picture recording device including switching control.

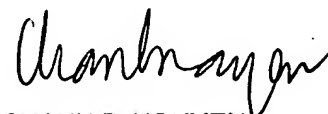
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angel F. Gonzalez whose telephone number is 571-272-1702. The examiner can normally be reached on Monday - Friday, 07:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on 571-272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Angel F. Gonzalez  
2/21/07

  
CHANH D. NGUYEN  
SUPERVISORY PATENT EXAMINER